



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/694,058

10/28/2003

Sinikka Sarkkinen

061715-0411 (US36613)

3865

30542

7590

10/24/2008

FOLEY & LARDNER LLP

P.O. BOX 80278

SAN DIEGO, CA 92138-0278

EXAMINER

MANOHARAN, MUTHUSWAMY GANAPATHY

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

10/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/694,058	Applicant(s) SARKKINEN ET AL.	
	Examiner MUTHUSWAMY G. MANOHARAN	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 10, 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/22/2008 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13 and 16 are rejected under 35 U.S.C. 101 because the disclosed invention is the claimed invention is directed to non-statutory subject matter.

Claims 13 and 16 recite a computer program product, embodied on a computer readable medium. Neither the claims (as originally filed) nor the specification, specifically define a computer readable medium. Claims are broad enough that computer readable medium includes non-statutory subject matter such as signals or carrier waves which are non-statutory subject matter.

Claim Rejections - 35 USC § 112

Art Unit: 2617

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In **claim 13 and 16** Applicant recites “a computer program product embodied on a computer readable medium” and “computer code” which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toth et al. (hereinafter Toth) (US 7107066) in view of Eyuboglu et al. (hereinafter Eyuboglu) (US 7170871).

Regarding **claim 1**, Toth teaches a method comprising (Abstract; Figure 3):

Receiving a user equipment active list by a serving device of a radio access network from a serving device of a core network, said user equipment active list being associated with a multicast/broadcast service (Col. 3, lines 64-67; col. 4, lines 1-4; Col. 6, lines 32-35);

Including user equipment indicating a mode that a multicast/broadcast service is to be joined and being within a cell controlled by another controller (Col. 7, lines 5-16; Figure 1; Col. 6, lines 22-28);

Determining a location of a user equipment desiring to join the multicast/broadcast service by checking the user equipment active list, wherein said determining comprises checking the user equipment active list (Col. 7, lines 5-16);

Informing at least one joined user equipment about multicast/broadcast service("The user may be notified ", Col. 5, lines 63-67)

sending the user equipment active list to a device of the radio access network wherein the user equipment active list comprises, when applicable, user equipments, joining the multicast/broadcast service, within a cell controlled by another controlling device("current location of members", Col. 3, lines 64-66; Col. 4, lines 6-13; ; Col. 6, lines 32-35);

Toth did not teach specifically controlling device of the radio access network and receiving channel type configuration from the radio access network controller for the connection of the service to one or more user equipment. However, Eyuboglu teaches in an analogous art a controlling device of the radio access network (mobility/session manager, item 52 in Figure 2) and a method of receiving channel type configuration from the radio access network controller for the connection of the service to one or more user equipment ("the mobility manager/session manager provides the UATI Stores session parameters ... RNC retrieves the session information from the session manager", Col. 3, lines 49-54). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to have the controlling device of the radio access network and use the method of receiving channel type configuration from the radio access network controller for the connection of the service to one or more user equipments as taught by Eyuboglu in order to establish a connection of the MBMS service as taught by Toth. This modification helps to manage the transfer of session information between RNC's.

Note: mobility/session manager reads on controlling device of the radio access network, item 53 in Figure 2; mobility manager is responsible for maintaining the location information for every AT that is being served by RNC's under its control.

Claims 10, 13, 14-16 are rejected for the same reason as set forth in claim 1.

Response to Arguments

Applicant argues that (Pages 9-10),"explicit preamble of the claimed inventions which provides a "computer program product embodied on a computer readable

Art Unit: 2617

medium”, Thus claim 13 functional descriptive material, and, therefore statutory subject matter”.

Neither the claims nor the specification (as originally filed), specifically define a computer readable medium. Claims are broad enough that computer readable medium includes non-statutory subject matter such as signals or carrier waves which are non-statutory subject matter.

Applicant argues that (Page 10),”it was well known in the art at the time of filing of the present invention that such operations are readily implemented in computer program products”. The satisfaction of the enablement requirement does not satisfy the written description requirement. For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention.

Applicant's arguments with respect to prior art rejection of claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUTHUSWAMY G. MANOHARAN whose telephone number is (571)272-5515. The examiner can normally be reached on 7:00AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/

Supervisory Patent Examiner, Art Unit 2617